



CERTIFICATE OF MAILING  
UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington DC 20231 on February 11, 2003.

*Debbie L. Newton*

Dated: February 11, 2003

MERZ 30/dln

\* \* \* \* \*

Applicants : Christopher G. R. PARSONS, et al.  
Title : 1-AMINO-ALKYLCYCLOHEXANES AS 5-HT<sub>3</sub> AND  
NEURONAL NICOTINIC RECEPTOR ANTAGONISTS  
Serial No. : 09/597,102  
Filing Date : 20 JUN 2000  
Art Unit : 1617  
Examiner : Shaojia JAING, Ph.D.

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\* \* \* \* \*

OFFICE OF PETITIONS

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

STATUS INQUIRY AND SUBMISSION OF COPY OF RESPONSE

Sir:

A Final Rejection dated 05 JUN 2002 was received by the undersigned attorney.

In response thereto, a Response and Amendment After Final was submitted to the Patent Office on 03 AUG 2002 and was received in the Patent Office on 12 AUG 2002.

A status check through the PAIR system reveals that this Response has not been entered into the record of this application even though a later drawings submission has been. The Patent Office is respectfully requested to check the status of this Response.

In view of the above circumstances, a copy of the Response and Amendment After Final, along with a copy of the return post card showing receipt by the Patent Office, are enclosed for the convenience of the Examiner.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

  
G. PATRICK SAGE, Attorney #37,710

Dated: February 11, 2003  
Customer No. 25,666  
500 Columbia Plaza  
350 East Michigan Avenue  
Kalamazoo, MI 49007  
(616) 382-0030

Enclosure: Return Postal Card Receipt  
Copy of Response and Amendment After Final  
Copy of return post card

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Applicants : Christopher G. R. PARSONS, et al.  
Title : 1-AMINO-ALKYLCYCLOHEXANES AS  
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\* \* \* \* \*

Status inquiry with copy of Response and Amendment after  
Final and copy of return post card receipt.  
MERZ 30/dln  
February 11, 2003

Applicants : Christopher G. R. PARSONS, et al.  
Title : 1-AMINO-ALKYLCYCLOHEXANES AS  
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Status inquiry with copy of Response and Amendment after  
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MERZ 30/dln  
February 11, 2003

FOR AMT SAGE



# **Advisory Action**

AUG 11 2003

Application No.

09/597,102

Applicant(s)

PARSONS ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## **PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection. June 5, 2002 → Dec 5, 2002
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-17.

Claim(s) withdrawn from consideration: none.

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8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

SREENI PADMANABHAN  
PRIMARY EXAMINER

5/18/03

***Advisory Action***

This Office Action is a response to Applicant's amendment and response after FINAL filed on September 10, 2002 (a copy by Fax filed on March 3, 2003).

2. Applicant's proposed amended claim, deleting "anxiety disorders, schizophrenia, drug and alcohol abuse disorders, depressive disorders, cognitive disorders, Alzheimer's disease" and "Parkinson's disease, Tourette's pain" from the original claim, are not deemed to place the application in better form for appeals by materially reducing or simplifying the issues for appeal, as discussed further below.

5. Applicant's remarks filed on September 10, 2002 with respect to the rejection of claims 1-17 made under 35 U.S.C. 102(e) as being anticipated by Gold et al. (WO 99/01416) have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated June 5, 2002.

As discussed in the Final Rejection, Gold et al. disclose that the same 1-aminoalkylcyclohexanes as herein are useful in the treatment of CNS disorders or a living animal for alleviation of a condition which is alleviated by the NMDA receptor antagonists. The instant claims 1-17 are drawn to a method of treating a living animal for inhibition of progression or alleviation of a condition which is alleviated by a 5HT3 or neuronal nicotinic receptor antagonist such as emesis, crebellar tremor, and appetite disorders (see the instant claim 1) comprising same compounds herein. Therefore, the teachings of Gold et al. would be inherent in the instant claimed methods See *Ex parte*

*Novitski* 26 USPQ 2d 1389. Note that the amount of active compounds to be administered in instant invention is same as in Gold et al.

Even though Applicant's proposed amendment deleted "anxiety disorders, schizophrenia, drug and alcohol abuse disorders, depressive disorders, cognitive disorders, Alzheimer's disease" and "Parkinson's disease, Tourette's pain" from the original claims, the proposed amended claims are still seen to be anticipated by Gold et al. under the doctrine of inherency. See *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3d. 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001).

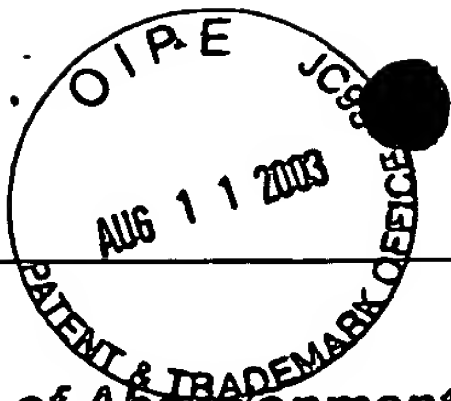
Therefore, Gold et al. anticipates the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.  
Patent Examiner, AU 1617  
March 17, 2003



# **Notice of Abandonment**

Application No.

09/597,102

Examiner

Shaojia A. Jiang

Applicant(s)

PARSONS ET AL.

Art Unit

1617

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 05 June 2002.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☒ A proposed reply was received on 12 August 2002, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.

The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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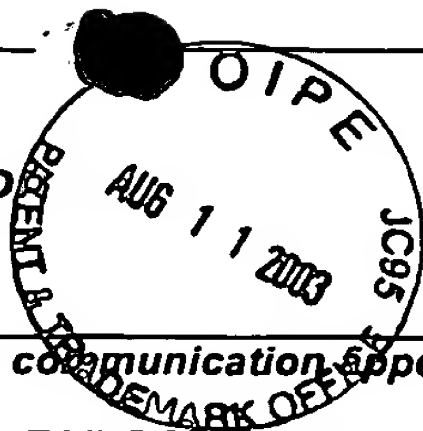
*Sreeni Padmanabhan*  
**SREENI PADMANABHAN**  
**PRIMARY EXAMINER**

*4/2/03*

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



Advisory Action



Application No.

09/597,102

Applicant(s)

PARSONS ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 12 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-17 (all).

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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RUSSELL TRAYERS  
PRIMARY EXAMINER  
GROUP 1200



***Advisory Action***

This Office Action is a response to Applicant's amendment and response after FINAL filed on August 12, 2002.

2. Applicant's proposed amended claim, deleting "anxiety disorderes, schizophrenia, drug and alcohol abuse disorders, depressive disorders, cognitive disorders, Alzheimer's disease" and "Parkinson's disease, Tourette's pain" from the original claim, present a new issue for search and consideration by the Examiner,

5. Applicant's remarks filed August 12, 2002 with respect to the rejection of claims 1-17 made under 35 U.S.C. 102(e) as being anticipated by Gold et al. (WO 99/01416) have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated June 5, 2002.

As discussed in the Final Rejection, Gold anticipates the claimed invention.

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Application/Control Number: 09/597,102  
Art Unit: 1617

Page 3

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.  
Patent Examiner, AU 1617  
August 19, 2002